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LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

| EXAMINER |
|---|
| SAADAT, CAMERON |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3713 | |

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

LC

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/835,046 | CORN ET AL. | |
| | Examiner | Art Unit | |
| | Cameron Saadat | 3713 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *4/13/01* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

# Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "searching said educational units based upon a user-supplied profession of the author of said educational unit" is unclear.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

**4. Claims 8-17, 19-20 rejected under 35 U.S.C. 102(e) as being anticipated by Lotvin et al. (U.S. Patent No. 5,907,831).**

Regarding claim 8, Lotvin et al. discloses a method comprising the steps of: providing a page having one or more educational units and one or more advertising units; associating one or more of said advertising units with one or more of said educational units such that said advertising unit is displayed in connection with said educational unit (column 8, lines 5-12).

Regarding claim 9, Lotvin et al. discloses a method wherein a plurality of said advertising units constitutes an advertisement (column 8, line 10).

Regarding claim 10, Lotvin et al. discloses a method wherein said advertising units are indexed to said educational units (column 8, lines 5-12).

Regarding claim 11, Lotvin et al. discloses a method wherein said advertising units displayed are specific to the user (column 6, line 64 – column 7, line 5).

Regarding claim 12, Lotvin et al. discloses a method wherein said advertisement is part of a sequence of advertising, said sequence of advertising being synchronized with the sequence of educational units (column 8, lines 10-12).

Regarding claim 13, Lotvin et al. discloses a method comprising the further step of: forwarding said educational unit and an associated advertisement to a user-designated recipient (column 8, lines 10-12).

Regarding claim 14, Lotvin et al. discloses a method comprising the steps of: providing a plurality of pages holding educational content, said educational content grouped by topics, said topics divided into a plurality of educational units providing substantially complete content (column 3, lines 11-22), said educational units stored on said web pages; receiving a request from a user of an electronic device interfaced with said network for one of said pages; forwarding said page in response to said request (column 9, lines 46-57); receiving an indication from said user that said user has completed reviewing said educational content (see Fig. 5B, ref. 520).

Regarding claim 15, Lotvin et al. discloses a method wherein said educational unit includes content for a professional user and a non-professional user (column 3, lines 31-45).

Regarding claim 16, Lotvin et al. discloses a method comprising the additional steps of: grouping selected educational units so as to form a course (column 3, line 37); registering said user for said course; and sending said educational units forming said course to said electronic device for review by said user (column 7, lines 45-48).

Regarding claim 17, Lotvin et al. discloses a method comprising the additional steps of: providing user response to the author of said educational units after said user reviews said educational units; and altering other educational units based on said user response (column 8, lines 25-27; column 5, lines 29-38).

Regarding claim 19, Lotvin et al. discloses a method comprising the additional step of: providing a search feature for said educational unit, said search feature searching multiple educational units on a plurality of web pages utilizing a single query (column 6, lines 30-33).

Regarding claim 20, Lotvin et al. discloses a method comprising the steps of: providing a plurality of web pages, said web pages including educational units providing substantially complete content, said educational units stored on said web pages; receiving a request from a user of an electronic device interfaced with said network for a search of said educational units (column 9, lines 46-57); and searching said educational units based upon a user-supplied profession of the author of said educational unit (column 6, lines 30-33).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**7. Claims 1-7, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lotvin et al. (U.S. Patent No. 5,907,831) in view of Sonnenfeld (U.S. Patent No. 6,112,049).**

Regarding claims 1 and 7, Lotvin et al. discloses a method comprising the steps of: sending a request from a user for a page having educational content over the network; receiving said page; displaying the content to a user (column 9, lines 46-58); tracking and recording the time the user views the educational content (column 11, lines 49-51) to ensure said user views said content for a time less than or equal to a maximum time period (column 11, lines 65-67). It is not explicitly stated that a time greater than or equal to a minimum time period is tracked and recorded. However, Sonnenfeld discloses a method wherein the minimum amount of time that a user must view educational content is tracked and recorded (column 6, lines 55-56). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the time tracking described by Lotvin et al., and tracking the time a user views educational content wherein the time must be greater than or equal to a minimum time period, in light of the teachings of Sonnenfeld. The motivation for doing so would have been to use the time that a user allocates on viewing educational content as an evaluation parameter for user performance.

Regarding claim 2, Lotvin et al. discloses a method wherein the user receives continuing education credit for viewing the educational content (column 6, lines 11-13).

Regarding claim 3, Lotvin et al. discloses a method wherein educational content is presented to a user in the form of interrogatory and related answer (column 3, lines 11-22). Although it is not explicitly disclosed that the educational content is presented daily, it is the examiner's position that it would have been an obvious matter of choice well within the capabilities of one skilled in the art to provide the educational content as frequently as desired. Hence, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify presentation of educational materials as described by Lotvin et al., and presenting the materials daily, to provide sufficient presentation of educational materials as desired by the user.

Regarding claim 4, Lotvin et al. discloses a method comprising the additional steps of: recording the amount of credit granted to each user; and providing the amount of credit granted to each user to said user upon request (column 9, lines 7-9).

Regarding claim 5, Lotvin et al. discloses a method wherein said method does not award educational credit to a user of said electronic device for reviewing said educational content as a result of the recorded amount of time exceeding a maximum time parameter (see Fig. 5B, ref. 520).

Regarding claim 6, Lotvin et al. discloses a method comprising the additional steps of: sending a message 521 to the user indicating that an exceeded amount of time has been spent reviewing said educational content, said message generated as a result of the recorded amount of time exceeds a maximum time parameter; receiving subsequently from said user a new recorded

amount of time 508; and awarding educational credit 529 to the user based on said new recorded amount of time. It is not explicitly disclosed that a message is sent to a user indicating an inadequate time spent on reviewing educational content. However, Sonnenfeld teaches a method wherein criteria for a user viewing educational materials includes a minimum amount time required to review educational content (column 6, lines 55-56). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the message indicator described by Lotvin et al., to provide a message for the criteria of spending inadequate time viewing educational materials, in light of the teachings of Sonnenfeld. The motivation for doing so would have been to use the time that a user allocates on viewing educational content as an evaluation parameter for user performance.

Regarding claim 18, Lotvin et al. discloses a method comprising the additional steps of: presenting said educational unit to said user in the format of a crossword puzzle (column 11, lines 41-44); and using said crossword puzzle completion as a basis for awarding continuing education units to said user (column 6, lines 11-13). It is not explicitly stated that hyperlinks are provided to the correct answers for said crossword puzzle. However, Sonnenfeld teaches a method wherein hyperlinks of correct answers of educational units are provided (column 9, lines 43-44). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the educational unit described by Lotvin et al., by providing hyperlinks to correct answers, in light of the teachings of Sonnenfeld, thereby providing the user with feedback on his/her performance on the educational unit.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Miles et al. (U.S. Patent No. 6,102,406) – discloses educational units wherein answers are provided on web pages comprising advertisements.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

CS
November 18, 2002

VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700